

b) forming an open pocket within said cornea through said incision; and

C2
Cancel
c) inserting a continuous ring implant into said open pocket through said incision, said continuous ring implant being inserted into an arc-shaped tube prior to insertion into said open pocket.

A marked up copy of the claims showing proposed claim amendments is attached to the end of this paper.

II. REMARKS

Claims 1-17, 20, 21, 23 and 24 are pending in the subject application and stand variously rejected under 35 U.S.C. §§ 112, 102 and 103. Claims 3, 8, 14, 20 and 21 have been canceled without prejudice or disclaimer. The cancellation of these claims is not intended to be a dedication to the public of the subject matter of the claims nor a surrender of any equivalents thereof. Claims 11, 12, 13 and 24 have been amended. Support for the amendments can be found in the specification on pages 32 through 37. An issue of new matter is not raised by these amendments and entry thereof is respectfully requested. Amended claims 1, 2, 4 to 7, 9 to 13, 15 to 17, 23 and 24 are presently under examination.

In view of the preceding amendments and the remarks which follow, reconsideration and removal of these rejections are respectfully requested.

35 U.S.C. § 112, Second Paragraph

Claims 8-11, 23, and 24 stand rejected under 35 U.S.C. § 112, second paragraph as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter regarded as Applicant's invention. The cancellation of claim 8 without prejudice or disclaimer has obviated the rejection of the claim. The Office objected to claim 24 on the ground that the term "open" should replace "opening". Claim 24 has been amended as suggested by the Office, thereby removing the grounds for rejection. Removal of the grounds for rejection are respectfully requested.

35 U.S.C. § 102

Claims 1 to 3, 14 to 17, 20 and 21 stand rejected under 35 U.S.C. § 102(e) as allegedly anticipated by Peyman, U.S. Patent No. 5,964,748. The Office alleged that claim 1 is anticipated by the language of the '748 patent, in particular: column 12, lines 34 to 40; column 13, lines 32 to 35; column 15, lines 58 to 66 and column 17 lines 28 to 31. The Office also cited the embodiments of Figures 37 to 45 (column 15, lines 30 et seq.)

noting:

“a small incision 418 is cut in the anterior surface of the cornea (column 15, lines 42 to 47), a circular channel is widened in certain locations to accommodate a ring of non-uniform cross-section (column 18, lines 4 to 11; column 13, lines 30 to 39; column 3, lines 58 to 61; column 17, lines 28 to 31; column 21, lines 46 to 49), and the intracorneal implant 430 is introduced into the widened channel through the small incision 418 (column 16, lines 63 to 67).”

Paragraph spanning pages 1 and 2 of the Office Action.

The Office also noted the embodiment depicted in Figure 89 (column 29, lines 45 to 58).

Applicant respectfully traverses. Amended claim 1 and its dependants (claims 2, 3, 14 to 17, 20 and 21) is directed to a method for correcting defects in vision by cutting a small incision in the anterior surface of the cornea of the eye, creating a circular intracorneal channel originating at said incision and widening the channel to create a widened channel and inserting an intracorneal implant into the widened channel through said incision. The '748 patent fails to teach or enable this method because it fails to describe a method that utilizes a widened, circular intracorneal channel originating at said incision to insert an intracorneal implant into the channel.

Column 12, lines 31 to 39 describes the creation of an incision into the cornea into which a laser or spatula is inserted to create an intrastromal or internal pocket (column 12, line 44). Column 12, line 40 through column 13, line 39 further describes the formation of a pocket. Column 15, line 30 to column 18, line 14 (Figures 37 to 45) also

describe a method wherein a pocket is formed from the initial incision but further includes removal of corneal tissue. The embodiment of Figures 46 to 53 (described in column 18, line 15 through column 19, line 46) the inserts are “radially directed” (column 18, line 25) with a flat pin, laser or blade spatula. Opaque portions of the eye are also removed (column 18, line 18). Figure 89 illustrates an embodiment wherein the cornea is dissected to form a small corneal flap (column 29, lines 45 to 49).

With respect to amended claims 12, 13, 24 and their dependents, the ‘748 patent fails to teach, suggest or enable the claims because fails to enable or teach the use of widening said circular intracorneal channel by inserting a clockwise pocket-forming dissector blade having a side-leg through said incision (see claims 12 and 13). The ‘748 patent also does not teach or enable the use of an arc-shaped tube to insert a continuous ring implant into the pocket (claims 23 and 24).

Thus, upon reading the cited portions of the patent in their proper context, it is clear that the ‘748 patent does not teach or suggest the invention of claims 1 and 24 and their dependents. Reconsideration and removal of the rejections is respectfully requested.

35 U.S.C. § 103

Claims 6, 8 to 11, 13, 23 and 24 stand rejected under 35 U.S.C. § 103 as allegedly obvious the ‘748 patent. Claims 4, 5, 7 and 12 stand rejected as allegedly obvious over the ‘748 patent in view of Mathis et al., U.S. Patent No. 5,846,256 (the ‘256 patent). Applicant respectfully traverses. The ‘256 patent was cited for teaching the employment of clockwise and counter-clockwise dissectors and channel connectors. Applicant respectfully traverses.

Applicant re-asserts and incorporates by reference the remarks in response to the rejections under 35 U.S.C. § 102. The rejected claims are not taught or suggested by the ‘478 patent because the patent fails to teach or suggest the creation of a circular intracorneal channel. The patent discloses the creation of multiple radial channels or a pocket using Applicant’s claimed pocket-forming dissecting blade having a side leg. The rejections are in error and Applicant respectfully requests their removal.



III. CONCLUSION

The Commissioner is hereby authorized to charge any additional fees which may be required by this paper, or credit any overpayment to Deposit Account No. 50-2518, referencing billing no.: 2023915-2239157312. If a telephone interview would advance the prosecution of this application, the Examiner is invited to telephone the undersigned attorney at the number provided below.

DATE:

Jan. 17, 2003

Respectfully submitted,

By: Antoinette F. Konski

Antoinette F. Konski

Registration No.: 34,202

Bingham McCutchen LLP
Formerly McCutchen, Doyle, Brown & Enersen, LLP
Three Embarcadero Center, Suite 1800
San Francisco, California 94111
Telephone: (650) 849-4950
Telefax: (650) 849-4800

RECEIVED

JAN 30 2003

TECHNOLOGY CENTER R3700

Serial No. 09/993,946
Docket No. AT 2036.00



Version of the Proposed Amendments to the Claims
with Markings to Show Changes Made

11. (Amended) The method of claim [8] 1, wherein said implant has a central aperture.
12. (Amended) The method of claim 1, further comprising [wherein] widening said circular intracorneal channel [comprises] by inserting a clockwise pocket-forming dissector blade having a side-leg through said incision and rotating the clockwise pocket-forming dissector blade clockwise to widen said circular intracorneal channel and inserting a counterclockwise pocket-forming dissector blade having a side leg through said incision and rotating the counterclockwise pocket-forming dissector blade counterclockwise to widen said circular intracorneal channel, thereby forming an intracorneal pocket.
13. (Amended) The method of claim 1, further comprising [wherein] widening said circular intracorneal channel [comprises] to a pocket by inserting a channel-widening dissector blade having a side leg through said incision and rotating the channel-widening dissector blade through said circular intracorneal channel to widen said circular intracorneal channel and inserting a pocket-forming blade having a longer side leg through said incision and rotating the pocket-forming dissector blade through said circular intracorneal channel to widen said circular intracorneal channel into an intracorneal pocket.
24. (Twice Amended) A method of inserting an intracorneal continuous ring implant in the cornea of an eye comprising:
- a) creating a small incision in said cornea;
 - b) forming an open [opening] pocket within said cornea through said incision; and

TECHNOLOGY CENTER R3700

RECEIVED
JAN 30 2003

c) inserting a continuous ring implant into said open pocket through said incision, said continuous ring implant being inserted into an arc-shaped tube prior to insertion into said open pocket.